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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FERNANDES, CHERYL M

ART UNIT PAPER NUMBER

2163

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/056,921	Applicant(s) HALL ET AL.	
	Examiner Cheryl M Fernandes	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/25/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-9 and 18-22 in the reply filed on June 14, 2004 is acknowledged.
2. Claims 10-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 14, 2004.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 18, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Number 6,049,796 issued to Siitonen et al (hereafter Siitonen).

Referring to claim 1, Siitonen discloses a method for sending data ('sending of E-mail messages', Abstract; col. 2, lines 15-29) using a communications device ('personal digital assistant (PDA)', Abstract; Fig. 1, elements 10a-b; Field of Invention; col. 2, lines 15-29; Fig. 2A-B), comprising:

- creating a data file for sending using said communications device ('E-mail or message' created by user using keyboard of PDA, col. 6, lines 59-67; Fig. 2B);
- retrieving at least one destination address from a user's personal database stored remotely from said communications device for sending said data file to said at least one address (E-mail addresses are retrieved from a remote contact database, col. 2, lines 38-45; col. 4, lines 38-46, 52-56; col. 4, line 63- col. 5, line 2; see Fig. 1, elements 11 and 18; Fig. 5B); and
- sending said data file to said at least one destination address (col. 6, line 59- col. 7, line 18; Fig. 5B).

Referring to claim 18, Siitonen discloses a system for sending data ('sending of E-mail messages', Abstract; col. 2, lines 15-29) from a communications device ('personal digital assistant (PDA)', Abstract; Fig. 1, elements 10a-b; Field of Invention; col. 2, lines 15-29; Fig. 2A-B) to a location defined by data in a user's personal database ('contact database' contains E-mail addresses to which the E-mail messages are sent, Fig. 1, elements 11 and 18; col. 2, lines 38-45; col. 4, lines 38-46, 52-56; col. 4, line 63- col. 5, line 2; Fig. 5B), comprising:

- a communications device ('personal digital assistant (PDA)', Abstract; Fig. 1, elements 10a-b; Field of Invention; col. 2, lines 15-29; Fig. 2A-B) for sending data ('sending of E-mail messages', Abstract; col. 2, lines 15-29; col. 6, lines

- 59-69) to at least one specified address (col. 6, line 69 –col. 7, line 2; see Fig. 5B); and
- means for accessing a personal database stored remotely from said communications device to retrieve the at least one specified address (E-mail addresses are retrieved from a remote contact database, col. 2, lines 38-45; col. 4, lines 38-46, 52-56; col. 4, line 63- col. 5, line 2; see Fig. 1, elements 11 and 18; Fig. 5B).

Referring to claim 23, Siitonen discloses that the communications device is an imaging device (see 'PDA display screen', Fig. 1, element 3; Fig. 2A-B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siitonen as applied to claim 1 above, and further in view of Patent Number 6,304,898 issued to Shiigi.

Referring to claims 2-4, Siitonen discloses all of the above claimed subject matter and also discloses:

- accessing a personal database of said user (claim 2)(col. 4, line 63- col. 5, line 2; col. 6, line 59 – col. 7, line 5).

However Siitonen remains silent as to:

- identification of a user of said communications device (claim 2);
- logging onto a server for hosting a storage media for storing said personal database of said user, retrieving data from said personal database of said user, and displaying said retrieved data to said user through said communications device (claim 3); and
- connecting to said server using the Internet (claim 4).

However, Shiigi teaches analogous art that includes:

- identification of a user of a communications device (claim 2)('user authentication', col. 4, lines 32-34; 'PDAs', col. 3, lines 49-55);
- logging onto a server for hosting a storage media for storing a personal database of said user, retrieving data from said personal database of said user, and displaying said retrieved data to said user through said communications device (claim 3)(col. 4, lines 25-42 and 63-65);
- connecting to said server using the Internet (claim 4)(col. 3, lines 35-39).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Siitonen to include user identification of a communications device, logging onto a server storing a personal database, retrieving and displaying said retrieved data, and connecting to said server using the Internet, as taught by Shiigi.

The ordinary skilled artisan would have been motivated to modify Siitonen per the above for the purpose of allowing users to compose, store, send, receive and view a handwritten or handdrawn message through Internet connected devices (Shiigi, col. 2, lines 7-14).

5. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siitonen as applied to claim 1 above, and further in view of Shiigi.

Referring to claim 5, Siitonen discloses all of the above claimed subject matter and also discloses:

- selecting at least one destination address from said user's personal database with said communications device (claim 5)(Siitonen, see Fig. 5B).

However referring to claim 5, Siitonen remains silent as to:

- retrieving a server location associated with a user from a directory service, accessing said server location, and accessing said user's personal database through said server location.

However, Shiigi teaches analogous art that includes:

- retrieving a server location associated with a user from a directory service, accessing said server location, and accessing a user's personal database through said server location (col. 4, lines 26-34; col. 4, lines 63-65; col. 8, lines 39-49).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Siitonen to include retrieving a server location associated with a user from a directory service, accessing said server location, and accessing a user's personal database through said server location, as taught by Shiigi.

The ordinary skilled artisan would have been motivated to modify Siitonen per the above for the purpose of maintaining lists of registered and currently active users, and enabling electronic messaging that allows for the identification and registration of authenticated users (Shiigi, col. 8, lines 41-45).

Referring to claims 6 and 7, the combination of Siitonen/Shiigi discloses prompting said user to enter a secure identification string into said communications device, connecting to said directory service, and determining said server location and username from data associated with said secure identification string accessible to said director service (Shiigi, col. 8, lines 39-61).

Referring to claim 8, the combination of Siitonen/Shiigi discloses selecting at least one destination address from the group consisting of e-mail addresses, facsimile numbers, phone numbers, and uniform resource locators (Siitonen, col. 4, lines 52-56; col. 6, lines 51-58; Fig. 3).

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siitonen as applied to claim 1 above, and further in view of Shiigi.

Referring to claim 24, Siitonen discloses all of the above claimed subject matter and also discloses:

- accessing the personal database of said user to retrieve the at least one destination address (Siitonen, col. 4, line 63- col. 5, line 2; col. 6, line 59 – col. 7, line 5; Fig. 5B).

However referring to claim 24, Siitonen remains silent as to:

- identifying a user of said communications device;
- connecting to a directory server for retrieving a username of said user and a server identification;
- constructing a messaging application program interface profile for connecting to a server associated with said server identification; and
- connecting to said server, logging in to said server as said user using said username.

However, Shiigi teaches analogous art that includes:

- identifying a user of a communications device (Shiigi, 'user authentication', col. 4, lines 32-34; 'PDAs', col. 3, lines 49-55);
- connecting to a directory server for retrieving a username of said user and a server identification (Shiigi, col. 4, lines 26-34 and 63-65);
- constructing a messaging application program interface profile for connecting to a server associated with said server identification (Shiigi, 'Handwriting Messaging server', Fig. 1B); and
- connecting to said server, logging in to said server as said user using said username (Shiigi, col. 8, lines 30-49).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Siitonen to include identifying a user of a communications device, connecting to a directory server for retrieving a username of said user and a server identification, constructing a messaging application program interface profile for connecting to a server associated with said server identification, and connecting to said server, logging in to said server as said user using said username, as taught by Shiigi.

The ordinary skilled artisan would have been motivated to modify Siitonen per the above for the purpose of maintaining lists of registered and currently active users, and enabling electronic messaging that allows for the identification and registration of authenticated users (Shiigi, col. 8, lines 41-45).

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siitonen, in view of Shiigi, as applied to claim 5 above, and further in view of Patent Number 6,609,121 issued to Ambrosini et al (hereafter Ambrosini).

Referring to claim 9, the combination of Siitonen/Shiigi discloses all of the above claimed subject matter but fails to disclose a lightweight directory access protocol interface.

However, Ambrosini teaches analogous art that includes a lightweight directory access protocol interface (Abstract; Fig. 1-2).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the combination of Siitonen/Shiigi to include a lightweight directory access protocol interface, as taught by Ambrosini.

The ordinary skilled artisan would have been motivated to modify the combination of Siitonen/Shiigi per the above for the purpose of using an industry standard directory services protocol, which can provide a consistent and controlled system for accessing data (Ambrosini, col. 2, lines 16-20).

8. Claims 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siitonen, as applied to claim 18 above, and further in view of Shiigi.

Referring to claims 19 and 22, Siitonen discloses all of the above claimed subject matter but remains silent as to:

- a server that stores said personal database (claim 19);

- means for connecting to an Internet connection for facilitating communications between said communications device and said server (claim 22).

However, referring to claims 19 and 22, Shiigi teaches analogous art that includes:

- a server that stores a personal database (claim 19) ('server computer', col. 4, lines 26-42; Fig. 1B, element 220);
- means for connecting to an Internet connection for facilitating communications between a communications device and said server (claim 22) (see Fig.1A).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Siitonen to include a server that stores a personal database and means for connecting to an Internet connection for facilitating communications between a communications device and said server, as taught by Shiigi.

The ordinary skilled artisan would have been motivated to modify Siitonen per the above for the purpose of receiving and storing graphical email messages (Shiigi, col. 4, lines 36-38) through communications with multiple client computers in a multi-user network (or Internet) (Shiigi, col. 3, lines 35-39; col. 4, lines 26-29).

Referring to claim 20, the combination of Siitonen/Shiigi discloses storing said personal database on a server in communication with said communications device (Shiigi, server computer containing database is in communication with client computer, Fig. 1A; col. 3, lines 33-58).

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siitonen, as applied to claim 18 above, and further in view of Ambrosini.

Referring to claim 21, Siitonen discloses all of the above claimed subject matter but fails to disclose a lightweight directory access protocol interface.

However, Ambrosini teaches analogous art that includes a lightweight directory access protocol interface (Abstract; Fig. 1-2).

It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Siitonen to include a lightweight directory access protocol interface, as taught by Ambrosini.

The ordinary skilled artisan would have been motivated to modify Siitonen per the above for the purpose of using an industry standard directory services protocol, which can provide a consistent and controlled system for accessing data (Ambrosini, col. 2, lines 16-20).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents or publications are cited with respect to routing of text to an electronic mail inbox:

- US Patent Number 5,732,126 issued to Fitzpatrick et al.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl M Fernandes who can be reached on (571) 272-4018. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 23, 2004
CMF



UYEN LE
PRIMARY EXAMINER